UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,861	01/05/2001	Evan S. Huang	-2276-03	3985

			EXAMINER
26797	7590	03/31/2004	NGUYEN BA, PAUL H

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ART UNIT	PAPER NUMBER
2176	

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Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _04/23/2001_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-20_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _2_.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   This action is responsive to Informational Disclosure Statement filed on April 23, 2001.

2.   Claims 1-20 have been considered. Claims 1, 14, and 20 are independent claims.

Priority

3.   Acknowledgment is made of applicant's claim of priority under 35 U.S.C. 119(e) from

Provisional Application 60/179,330, filed on January 31, 2000.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwahara,

U.S. Patent No. 6,202,072, in view of Christiano, U.S. Patent No. 5,386,369.

Independent Claim 1

Kuwahara discloses a method for *providing document conversion process* (see Abstract

→ creation of a structured (SGML) document from a plain text document), the method

comprising:

converting an *unstructured document into a metafile* (see Figs. 2, 3; see also col. 2, lines

21-29; → i.e. prototype into a plain text document), wherein the metafile including a number of

displayable objects and *respective decoration attributes* about each of the displayable objects

(see Fig. 3 - item a; column 6 lines 17-27 → form with field elements including displayable

objects and decorative attributes);

receiving a definition file including document type definitions (DTD) relating to the

unstructured document (Fig. 1; column 5, lines 6-15 → receiving a document type definition

(DTD) file that is correlated to the prototype file based upon the plain text file respectively); and

generating a *modified metafile* including *association information of at least one of the*

displayable objects associated with one of the definitions in the definition file (Figs. 2, 3, and 8;

Abstract; col. 8, lines 60-67).

Kuwahara does not specifically disclose activating a counter having a numbering system

and causing the counter to increment as soon as the modified metafile is to be saved.

However, Christiano discloses a software metering system that activates a counter having

a numbering system and causes the counter to increment (see Abstract, col. 5, lines 42-57; see

also Fig. 5) for the purpose of monitoring and/or controlling the usage of software applications

(col. 1 lines 5-9).

Since Kuwahara and Christiano are both from the same field of endeavor, the purposes

disclosed by Christiano would have been recognized in the pertinent art of Kuwahara. It would

have been obvious at the time the invention was made to a person having ordinary skill in the

art to modify the teaching of Kuwahara with the teachings of Christiano to include activating a

counter having a numbering system and causing the counter to increment as soon as the

modified metafile is to be saved for the purpose of monitoring and/or controlling the usage of software applications.

Claim 2-4

Kuwahara discloses the method with respect to claim 1 explained above, but does not specifically disclose the numbering system including a first number from which the counter can increment and a second number the counter can not exceed, wherein both of the first and second numbers are re-configurable by a business entity, and wherein the business entity charges fees in accordance with the first and second numbers.

However, Christiano discloses a software metering system wherein the meter is set to a chosen value (upper limit, which corresponds to that amount of usage the user has paid for) by the licensor/distributor and a counter which increments until it reaches the chosen value for which the counter cannot exceed (col. 3, lines 26-37) for the purpose of monitoring and/or controlling the usage of software applications (col. 1 lines 5-9).

Since Kuwahara and Christiano are both from the same field of endeavor, the purposes disclosed by Christiano would have been recognized in the pertinent art of Kuwahara. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Kuwahara with the teachings of Christiano to include a meter with a numbering system set to a chosen value (upper limit, which corresponds to that amount of usage the user has paid for) by the licensor/distributor and a counter which increments until it reaches the chosen value for which the counter cannot exceed for the purpose of monitoring and/or controlling the usage of software applications.

Claim 5

Kuwahara discloses the method with respect to claims 1, 2, and 3 explained above, but does not specifically disclose the method wherein both of the first and second numbers are stored in a dongle that must be consulted every time the modified metafile is to be saved.

However, Christiano discloses a *dongle* including a meter (stored second number) and counter (stored first number) (see Abstract, col. 2, lines 46-67 *et seq.*) for the purpose of monitoring and/or controlling the usage of software applications (col. 1 lines 5-9).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Kuwahara with the teachings of Christiano to include a *dongle* including a meter (stored second number) and counter (stored first number) that must be consulted every time the modified metafile is saved for the purpose of monitoring and/or controlling the usage of software applications.

Claim 6

Kuwahara discloses the method with respect to claims 1, 2, 3, and 5 explained above, but does not specifically displaying a message that the first and second numbers are to be reconfigured when the first number is substantially close to the second number in the dongle.

However, Christiano discloses setting the status of the meter to "out of slots" a forwarding a suitable message when the first number reaches the second number (see col. 5, lines 42-57; see also Fig. 5) for the purpose of monitoring and/or controlling the usage of software applications (col. 1 lines 5-9).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Kuwahara with the teachings of Christiano to

include displaying a message that the first and second numbers are to be reconfigured when the

first number is substantially close to the second number in the dongle for the purpose of

monitoring and/or controlling the usage of software applications.

Claim 7

Kuwahara discloses the method of claim 1 further comprising *converting modified*

metafile to a markup language file in accordance with a set of mapping rules (see Abstract; col.

8, lines 31-67; Figs. 2, 3, and 8).

Claim 8

Kuwahara discloses the method of claim 1, wherein the *definition file includes a structure*

for document elements, each corresponding to one of the displayable objects in the metafile (see

Fig. 2 → definition file wherein sub-document elements associated with displayable objects).

Claims 9, 10

Kuwahara discloses the method of claim 8, wherein at least some of the document

elements include respectively a *number of identifiers* (numerals and/or alphabets), *each of the*

identifiers being assigned to one of the at least some of the document elements (Figs. 2, 3 →

structure comprising document elements, said elements identified with various alphanumeric

input data (i.e. string data)).

Claim 12

Kuwahara discloses the method with respect to claim 1 explained above, wherein some of

the displayable objects are respective *groups of characters and/or graphic representations* (see

Fig. 3 → i.e. group of characters).

Independent Claim 14

With respect to independent claim 14, refer to the rationale relied upon to reject claim 1.

Furthermore, although Kuwahara does not specifically disclose the product controlled by a

dongle coupled to the computing device and including a set of instructions to start the document

conversion process and causing the counter in the dongle to increment, Christiano discloses a

dongle coupled to the computing device including a meter (stored second number) and counter

(stored first number) (see Abstract, col. 2, lines 46-67 *et seq.*) for the purpose of monitoring

and/or controlling the usage of software applications (col. 1 lines 5-9).

It would have been obvious at the time the invention was made to a person having

ordinary skill in the art to modify the teaching of Kuwahara with the teachings of Christiano to

include a *dongle* coupled to the computing device including a meter (stored second number) and

counter (stored first number) that must be consulted every time the modified metafile is saved for

the purpose of monitoring and/or controlling the usage of software applications.

Claims 15-17

Kuwahara discloses the method with respect to claim 14 explained above, but does not

specifically disclose the numbering system including a first number from which the counter can

increment and a second number the counter can not exceed, wherein both of the first and second

numbers are re-configurable by a business entity, and wherein the business entity charges fees in

accordance with the first and second numbers.

However, Christiano discloses a software metering system wherein the meter is set to a

chosen value (upper limit, which corresponds to that amount of usage the user has paid for) by

the licensor/distributor and a counter which increments until it reaches the chosen value for

which the counter cannot exceed (col. 3, lines 26-37) for the purpose of monitoring and/or

controlling the usage of software applications (col. 1 lines 5-9).

Since Kuwahara and Christiano are both from the same field of endeavor, the purposes

disclosed by Christiano would have been recognized in the pertinent art of Kuwahara. It would

have been obvious at the time the invention was made to a person having ordinary skill in the art

to modify the teaching of Kuwahara with the teachings of Christiano to include a meter with a

numbering system set to a chosen value (upper limit, which corresponds to that amount of usage

the user has paid for) by the licensor/distributor and a counter which increments until it reaches

the chosen value for which the counter cannot exceed for the purpose of monitoring and/or

controlling the usage of software applications.

Claim 18

Claim 18 incorporates substantially similar subject matter as claim 7, and is rejected

along the same rationale.

Claim 19

Kuwahara discloses the method of claim 18 wherein the *unstructured document is a*

metafile generated from a file composed/edited/managed by authoring tool (Figs. 2, 3, and 8;

Abstract; col. 6, lines 17-27 → i.e. prototype).

Independent Claim 20

Kuwahara discloses a method for providing document conversion process (see Abstract

→ creation of a structured (SGML) document from a plain text document), the method

comprising:

an unstructured document including a number of displayable objects and respective

decoration attributes about each of the displayable objects therein (see Fig. 3 - item a; column 6

lines 17-27 → form with field elements including displayable objects and decorative attributes)

wherein the *file format is generated from a modified metafile including association information*

of at least one of the displayable objects being associated with one of definitions in a definition

file prepared in reference to the unstructured document (Figs. 2, 3, and 8; Abstract; col. 8, lines

60-67).

Kuwahara does not specifically disclose offering a product executable on a computing

device the product controlled by a dongle, coupled to the computing device and including a set

of instructions to start the document conversion process, wherein a counter is associated with

the dongle that includes a first number from which the counter can increment and a second

number the counter can not exceed and causing the counter to increment.

However, Christiano discloses a dongle executable wherein the dongle is set to a chosen

value (upper limit, which corresponds to that amount of usage the user has paid for) by the

licensor/distributor and a counter which increments until it reaches the chosen value for which

the counter cannot exceed (col. 3, lines 26-37) for the purpose of monitoring and/or controlling

the usage of software applications (col. 1 lines 5-9).

Since Kuwahara and Christiano are both from the same field of endeavor, the purposes

disclosed by Christiano would have been recognized in the pertinent art of Kuwahara. It would

have been obvious at the time the invention was made to a person having ordinary skill in the

art to modify the teaching of Kuwahara with the teachings of Christiano to include a dongle

with a numbering system set to a chosen value (upper limit, which corresponds to that amount

of usage the user has paid for) by the licensor/distributor and a counter which increments until it

reaches the chosen value for which the counter cannot exceed for the purpose of monitoring

and/or controlling the usage of software applications.

7.   Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kuwahara, U.S. Patent No. 6,202,072, in view of Arn et al. ("Arn"), PCT International

Application Publication No. WO 94/14122, Application No. PCT/CA93/00525, Publication date:

23 June 1994.

Claim 11

Kuwahara does not specifically teach selection from a group of elements (font, color,

size, style, effect). However, Arn teaches selection from a group of element identifiers, including

a style (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the

invention to apply Arn to Kuwahara, providing a user of Kuwahara the convenience of selecting

from a group of elements associated with a document's DTD.

Claim 13

Kuwahara discloses the method with respect to claim 12 explained above, but does not

specifically disclose some of the decoration attributes including at least positions, font color,

font size, font type, style and effect for each of the groups of characters.

However, Arn teaches selection from a group of element identifiers, including a style

(Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the

invention to apply Arn to Kuwahara, providing a user of Kuwahara the convenience of selecting

from a group of elements some of the decoration attributes associated with a document's DTD.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

5,276,793	issued on	01/04/1994	Borgendale et al.
6,003,048	issued on	12/14/1999	Fallside

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Paul Nguyen-Ba whose telephone number is (703) 305-8776.

The examiner can normally be reached from 10 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

PNB